UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731

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EXAMINER
HAN, QI

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-14 and 16-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-14 and 16-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

2.   This communication is responsive to the applicant's Pre-Appeal Conference request filed on 12/09/2008. The Pre-Appeal Conference decision filed on 05/22/2009, indicated to reopen prosecution, so that the finality of the previous rejection filed on 08/15/2008 is withdrawn.

3.   It is noted that in this office action, the examiner introduces new ground rejection regarding claim 11 (see detail below). It is also noted that the applicant's representative and examiner had discussed the proposed amendment several times, including detailed explanation why claim 11 was not fully supported by the specification. However, no fully response has been received from the applicant(s) (also see the Interview Summary filed on 02/24/2009).

4.   Further, it is noted that the prior art rejection are still applicable to the previously represented claims for the corresponding claim rejection. Particularly, for all independent claims, it can be seen the combined teachings of the references based on a general propose computer with printer/plotter satisfy all features and capabilities of the claimed limitations, based on broadest reasonable interpretation of the claim(s), in light of (not read into) the specification.

In response to the applicant's arguments regarding rejection claims 1 6, 11, 14 and 17 that "Yamauchi fails to disclose the outputting of a group of printed documents consisting of the original document and the translated document data in each of a plurality of languages, each as separate documents", "Flores discloses only one document containing translated materials", "Flores fails to teach or suggest a translating device with each of the printed documents being distinct from one another, or separation or separate grouping of the translated documents from the original documents to make them distinct" (Remarks: page 10, last paragraph to page 11 paragraph 2), it is noted that the arguments against the references individually are not proper, because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicant's arguments regarding rejection claim 1, 6, 11, 14 and 17) that "the combination of Yamauchi and Flores fails to disclose the limitation" as claimed (Remarks: page 11, last paragraph to page 12, paragraph 1), the examiner respectfully disagrees with applicant's arguments and has a different view of the prior art teachings and the claim interpretations.

It is noted that Yamauchi teaches a multi-language translation system (col. 11, lines 37-45) that can output the documents in a first (original) language and a second (translated) language with different modes (corresponding to groups) (col. 41, lines 37-60) via a printer, plotter and/or personal computer (col. 1, lines 44-45; col. 7, lines 51-54). Yamauchi does not explicitly teach modes (groups) in that the document data comprise "a printed document in the original language and printed documents of the

translated document data translated in each of the plurality of languages with each of the

printed documents being distinct from one another", i.e. outputting printed documents in

one or more additional translated language(s). However, the feature of outputting

group(s) having documents in respective (distinct) multiple translated languages is well

known in the art as evidenced by Flores who discloses apparatus and methods for

multilingual user access (title), comprising that 'the database stores translation of

documents in multiple languages and a variety of formats' in 'a computer system', 'user

can choose to have the multiple translations' and 'to have a work displayed (output) in a

written text in two or more separate languages' (Figs. 2-4 and col. 3, line 64 to col. 4, line

54, and col. 5, lines 27-57), showing the database storing separate translated files or

tables (i.e. documents) (Fig. 4), and viewing and choosing two or more languages

presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B). Based on the

teachings of Yamauchi's multi-language translation system that can output printable

documents in the original language and one translated language, and teachings of Flores'

computer and database based multi-language translation system that can generate and

output (display) documents in multiple translated languages, as state above, one of

ordinary skill in the art would have recognized that providing capability of outputting

printable documents in multiple translated languages with different combination groups

would be easily implemented by combining these teachings in the computer-database

based multi-language translation system with printer and/or plotter, so that the combined

system could operate the functionality for grouping, sorting, and printing the

stored/generated multiple language documents in the same or similarly way as they are

used before, and the operation result would be predicable, to the ordinary skilled person.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Yamauchi and Flores by providing computer-database

based translation system translating and outputting (displaying or printing) document data

in multiple languages (including multiple translated languages) with different

combination groups (such as content groups, language groups, or common groups), for

the purpose (motivation) of being beneficial to users presenting a written (printed) text

and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

Regarding dependent claims, the response to the applicant's argument is based on

the same reason for the independent claims, as stated above, because the argument is

based on the same issue as independent claims (see above).

For above reasons, the applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which was

not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention.

Regarding claim 11, the limitation "translating means for translating a first

document data and a second document data, each in different languages, into another

language, different from the language of the first document data and the second document

data;…wherein, said controller controls said translating means so as to translate each of

the first document data and the second document data into a first language and a second

language, and controls said output unit so as to output the first and second document data

translated into the first language as a first group and the first and second document data

translated into the second language as a second group", introduces new subject matter

because the limitation is not specifically described in the original specification. It is

noted that the applicant failed to provide reference(s) (paragraphs or figures) in the

specification to indicate where the limitation came from.   Further, the examiner cannot

find any content in the specification/drawings to specifically and fully support the

limitation.

Claim Rejections - 35 USC § 103

6.   Claims 1, 4-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in

view of Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 1**, Yamauchi teaches a translating apparatus comprising:

"translating means for translating document data of a document into another

language" (Fig.1 and col. 7, lines 41-54, 'translation unit 9');

"an output unit for outputting the translated document data translated by said

translating means in printed form" (col. 4, line 36 to col. 5, line 11, 'output means for

outputting said received document (including translated document data in printed form);

Fig. 1, 'bitmap exp 10' and 'plotter 11', 'PC/WS 12'; col. 7, lines 54-55, 'the translating

unit 9 supplies the output text data…for transfer to the personal computer 12');

"a mode setting unit for setting the translating apparatus in a first mode or a

second mode" (col. 4, lines 36-60, 'wherein one of said first and second output means is

selectively activated (mode setting)');

"a controller", (col.,7, lines 55-56, 'the system of Fig. 1 includes a system controller',

which necessarily controls each unit, such as 'OCR', 'translation' and 'outputs

text data representing the result of translation');

"wherein, in a case where the first mode is set, said controller controls said translating

means so as to translate the document data into a plurality of languages, and

controls said output unit so as to output the translated document data by language

groups of printed documents, the language of each language group of printed

documents consisting of one of the plurality of languages", (col. 4, lines 39-45,

'translating a received document, written in a first language, to a second, different

language…output…in said second language… wherein one of said first and

second output means is selectively activated (setting mode)'; col.,7, line 48,

'outputs text data representing the result of translation' (necessarily including

printed document); col. 11, lines 40-45, 'translating English to Japanese' and/or

'English to French…'; Fig. 24, showing different pages (interpreted as printed

documents) in different language groups); and

"wherein, in a case where the second mode is set, said controller controls said translating

means so as to translate the document data into a plurality of languages, and

controls said output unit so as to output the document data by groups" (col. 4,

lines 39-45; col. 7, line 48; col. 11, lines 40-45 and Fig. 24, same as stated above).

Yamauchi does not explicitly teach in the second mode, "each group of the

document data comprising a printed document in the original language and printed

documents of the translated document data translated in each of the plurality of languages

with each of the printed documents being distinct from one another." However, the

feature of outputting group(s) having documents in respective (distinct) multiple

translated languages is well known in the art as evidenced by Flores who discloses

apparatus and methods for multilingual user access (title), comprising that 'the database

stores translation of documents in multiple languages and a variety of formats' in 'a

computer system', 'user can choose to have the multiple translations' and 'to have a work

displayed (output) in a written text in two or more separate languages' (Figs. 2-4 and col.

3, line 64 to col. 4, line 54, and col. 5, lines 27-57), showing the database storing separate

translated files or tables (i.e. documents) (Fig. 4), and viewing and choosing two or more

languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B). Based

on the teachings of Yamauchi's multi-language translation system that can output

printable documents in the original language and one translated language, and teachings

of Flores' computer and database based multi-language translation system that can

generate and output (display) documents in multiple translated languages, as state above,

one of ordinary skill in the art would have recognized that providing capability of

outputting printable documents in multiple translated languages with different

combination groups would be easily implemented by combining these teachings in the

computer-database based multi-language translation system with printer and/or plotter, so

that the combined system could operate the functionality for grouping, sorting, and

printing the stored/generated multiple language documents in the same or similarly way

as they are used before, and the operation result would be predicable, to the ordinary

skilled person. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to combine Yamauchi and Flores by providing

computer-database based translation system translating and outputting (displaying or

printing) document data in multiple languages (including multiple translated languages)

with different combination groups (such as content groups, language groups, or common

groups), for the purpose (motivation) of being beneficial to users presenting a written

(printed) text and its multiple translations in two or more separate languages (Flores: col.

4, lines 5-8).

As per **claim 4** (depending on claim 1), Yamauchi in view of Flores further

teaches "said output unit includes a display for displaying the translated document data"

(Yamauchi: Figs. 2 and col. 8, lines 33-34, 'display unit 33').

As per **claim 5** (depending on claim 1), Yamauchi in view of Flores further

teaches "an operation unit for specifying a plurality of original languages and at least one

language to be translated" (Yamauchi: Figs. 2 col. 7, lines 62, 'system controller', 'input

device 32 used by an operator'; col. 11, lines 40-45, 'the translation unit achieves

translation between other combination of languages…'; Fujita: col. 4, lines 4-8, 'user can

choose (specify) to have the multiple translations'; which necessarily includes specifying

original languages and translated languages as claimed).

As per **claim 6**, the rejection is based on the same reason described for claim 6,

because it also reads on the limitations of claim 6.

As per **claim 7** (depending on claim 6), Yamauchi further teaches "said output unit includes a printing device for printing the translated document data in a sheet" (Fig. 1, 'plotter 11').

As per **claims 8-9** (depending on claim 6), the rejection is based on the same reason described for claims 4-5, because the claims recite the same or similar limitations as claims 4-5 respectively.

As per **claim 10** (depending on claim 9), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations as claim 10.

As per **claim 11**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 11.

As per **claims 12-13** (depending on claim 11), the rejection is based on the same reason described for claims 7-8 respectively, because the claims recite the same or similar limitations as claims 7-8 respectively.

As per **claim 14**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 6.

As per **claim 16** (depending on claim 14), the rejection is based on the same reason described for claim 4, because the claim recites the same or similar limitations as claim 4.

As per **claim 17**, the rejection is based on the same reason described for claim 1, because it also reads on the limitations of claim 17.

As per **claim 18** (depending on claim 17), the rejection is based on the same

reason described for claim 1, because the rejection for claim 1 covers the same or similar

limitations as claim 18.

7.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi

in view of Flores as applied to claim 1, and further in view of Miyahara et al. (6,314,213

B1) hereinafter referenced as Miyahara.

As per **claim 3** (depending on claim 1), Yamauchi in view of Flores does not

explicitly teach "said output includes a sorter for sorting printed sheets by the group".

However, this feature is well known in the art as evidenced by Miyahara who teaches

using 'a sorter 22' for discharging 'paper sheet' (Fig.2) (col. 7, lines 28-29) and 'a soft

key which is used to sort, staple/sort') (col. 8, line 12). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine

Yamauchi in view of Flores by providing a sorter and/or related sorting functionality, as

taught by Miyahara, for the purpose of implementing user preferred function, like sorting

the resultant sheets (Miyahara: col. 8, lines 4-13).

Conclusion

8.   Please address mail to be delivered by the United States Postal Service (USPS) as
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to QI HAN whose telephone number is (571)272-7604. The examiner can normally be reached on M-TH:9:00-19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571)-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

        QH/qh
        July 8, 2009
        /Qi Han/
        Primary Examiner, Art Unit 2626